

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Christopher J. Elliott

Serial No.: 10/626,246

Filed: July 24, 2003

For: Embolic Coil

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) **Confirmation No.:** 1009

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) **Group Art Unit:** 3731

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) **Examiner:** Houston, Elizabeth

REPLY BRIEF-37 CFR §41.41

M/S: APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is in reply to the Examiner's Answer, dated October 20, 2010 (hereinafter "the Examiner's Answer"). Appellant agrees with the statements made in item numbers (1)-(8) and (11) of the Examiner's Answer, and responds to the statements made in item numbers (9) and (10) of the Examiner's Answer as follows:

In response to Appellant's argument that the fibers taught by Dormandy are not frictionally gripped between adjacent coils of the coil, the Examiner states (in the middle of p. 6 of the Examiner's Answer) that the fibers taught by Dormandy "necessarily are held in place by frictional forces between the fibers and the coil" and that "the coils are necessarily maintained in place by friction." Appellant submits that Dormandy does not teach or suggest that the *coils* are maintained in place by friction, and suggests that the Examiner intended to state that the *fibers* are maintained in place by friction.

Nevertheless, Appellant disagrees with the Examiner's characterization of Dormandy. Dormandy teaches that the fibers (22) are looped around turns of the coil (12) and that the "loop 23 serves as the sole means for retaining the group 21 of fibers 22 on the coil 12." See Dormandy, Figs. 3 and 4, and col. 3, lines 50-60. Thus, Dormandy teaches that the fibers are maintained in place by being looped around the turns of the coil, not by friction.

Further, Appellant respectfully submits that the Examiner's statements are not in commensurate scope with the claims on appeal. In particular, the Examiner has failed to address the "gripped" language in claims 1 and 24. Neither Dormandy or Kupiecki teaches or suggests fibers that are "***gripped*** between adjacent coils of the primary coil." Indeed, because adjacent coils of the coils taught by Dormandy and Kupiecki are spaced from one another, there is nothing to "grip" the fibers.

In response to Appellant's argument that the fibers (22) of Dormandy cannot be looped around the wire (202) of Kupiecki due to obstruction by the inner core member (204), the Examiner states (in the middle of p. 7 of the Examiner's Answer) that "[i]t would be will within the skill to determine how to incorporate the wrapped fibers of Dormandy into the coil of Kupiecki." However, Appellant maintains that, due to the configuration of the wire (202) and the core member (204) taught by Kupiecki, one of ordinary skill in the art would not understand how to incorporate Dormandy's fibers (22) into Kupiecki's coil.

Further, even if the cited references did teach fibers that are "gripped between adjacent coils" (which Appellant does not concede), one of ordinary skill in the art would not be motivated to incorporate Dormandy's fibers (22) into Kupiecki's coil, because doing so would render Kupiecki's coil unsatisfactory for its intended purpose. In

particular, the coil shown in Fig. 8 of Kupiecki is a retaining device, the function of which is to form a barrier at an aneurysm (4) and also to keep the lumen of the vessel (2) open (see, e.g., the retaining device 19 shown in Fig. 1C, and col. 8, lines 60-64 of Kupiecki). In contrast, the function of the fibers (22) taught by Dormandy is to increase thromogenicity of the embolization coil (12). Thus, modifying the retaining device shown in Fig. 8 of Kupiecki to include fibers such as those taught by Dormandy would render the retaining device unsatisfactory for its intended purpose of keeping the lumen of the vessel open. That is, incorporating Dormandy's fibers into Kupiecki's retaining device would enhance the formation of clots around the retaining device, thus blocking the flow of blood through the vessel.

Thus, Appellant respectfully maintains that neither Kupiecki nor Dormandy, taken either alone or in combination, disclose or suggest an embolic coil comprising a plurality of fibers that are "frictionally gripped between adjacent coils of the primary coil," as recited in claim 1, or "gripped between adjacent coils of the primary coil and held therebetween by friction," as recited in claim 24. As such, Appellant respectfully maintains that the Examiner has not set forth a prima facie case that claims 1, 2, 6-10, 24 and 26 are unpatentable under 35 U.S.C. § 103 (a), as being obvious over Kupiecki in view of Dormandy.

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Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: December 10, 2010

By:

/DavidTBurse/

David T. Burse

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